

Serial No.: 10/807,269
Docket No.: 801-1001
Reply to the Office Action of June 29, 2006

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1-74 are pending in the application. Claims 1, 2, 4, 8, 13, 18, 19, 26, 33, 34, 35 and 56 have been amended.

In particular, claim 1 now recites “a microprocessor to process the signal, to receive a further signal . . . and to operate” Support for amending claim 1 is found in the specification at page 6, paragraph [0026] regarding “bi-directional line 150” between “control unit 130” and “locking device 160” as illustrated in FIG. 1, for example.

Claim 2 is amended to further recite “wherein if the signal contains the predetermined signal to indicate whether the manual key is used within a set amount of time. . .” support for which is found at pages 5-6, paragraph [0026] stating:

The key detecting unit 110 reads the electronic key to detect a programmed identification code within the electronic key. Once the programmed identification code has been detected, the key detecting unit 110 sends a signal to the control unit 130 indicating that the proper identification code has been detected. Then the control unit 130 sends a signal through the bi-directional line 150 to the locking component 120, which in turn will allow the locking device 160 to be operated by the manufacturer for a predetermined amount of time. If the manufacturer provided key is not used to operate the locking device 160 within the predetermined amount of time, the control unit 130 receives a signal back from the locking component 120 indicating that the manufacturer provided key has not been used with the locking device 160. Then the control unit 130 controls the locking component 120 through the bi-directional line 150 to stop the locking device 160 from being operated by the manufacturer provided key. However, if the manufacturer provided key is used . . . within the predetermined amount of time, the control unit 130 receives a signal . . . indicating that the manufacturer provided key has been used . . . at which time the control unit 130 controls . . . to continue to enable the locking device to be operated . . . [(Emphasis added.)]

Additional support is found elsewhere in the specification originally filed for the amendments made.

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Amendments to claim 4 are grammatical in nature to change “indicating” to “to indicate” as noted at page 4 of this paper.

Amendments to claims 8, 18, and 26 are similar to those of claim 1. Amendments to claim 13 are similar to those of claim 2. Amendments to claims 19, 33, 34 and 35 are grammatical in nature and/or to improve clarity. Claim 56 is amended to correct a typographical error.

Accordingly, no new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Amendments to the Specification

A typographical error in paragraph [0026] is corrected so that the relevant sentence reads with the word “not” removed as indicated below:

However, if the manufacturer provided key is used to operate the locking device 160 within the predetermined amount of time, the control unit 130 receives a signal from the locking component 120, through the bi-directional line 150, indicating that the manufacturer provided key has ~~not~~ been used with the locking device 160, at which time the control unit 130 controls the locking component 120, through the bi-directional line 150, to continue to enable the locking device 160 to be operated by the manufacturer provided key for as long as the manufacturer provided key is used to access the locking device 160 of the compartment area. . . .
[(Emphasis added.)]

Further, in response to the rejection under 35 USC § 112, a new sentence has been added at the end of paragraph [0026] as indicated below.

Rejection under 35 USC § 112, first paragraph

Claims 39-74 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to satisfy the enablement requirement because there is no “written description” of the term “local key” for the reasons noted at page 2 of the Office Action.

In response, Applicants have amended the specification, paragraph [0026] bridging pages 6-7. As amended, paragraph [0026] now recites that:

[f]urther, a local key may be used which may be one of an

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electronic key, another electronic key and a manual key.
[(Emphasis added.)]

Support for such amendment to the specification is found in original claim 54 reciting “wherein the local key is one of another electronic key and a manual key” as noted in the Listing of Claims. The use of “another electronic key” in original claim 54 implies the local key can be an “electronic key” as well as “another electronic key” or a “manual key.” Therefore, no new matter is added by amending paragraph [0026] as noted.

In view of the foregoing amendment to the specification, Applicants respectfully submit that the term “local key” is sufficiently described to satisfy the requirements of 35 USC § 112, first paragraph.

Accordingly, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 39-74 under 35 USC § 112, first paragraph.

Rejections under 35 USC § 103(a)

Claims 1-2, 5, 18-22, 25 and 33-38 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,412,378 to Clemens (hereinafter “Clemens”) in view of U.S. Patent No. 5,170,431 to Dawson (hereinafter “Dawson”) for the reasons noted at pages 3-4 of the Office Action. In particular, with respect to method claims 33-38, these claims are rejected under 35 USC §103(a) as being obvious over Dawson for the reasons noted at page 4, lines 7-9, of the Office Action.

Claims 3-4 and 23-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Clemens in view of Dawson and further in view of U.S. Patent No. 5,204,663 to Lee (hereinafter “Lee”) for the reasons noted at page 4 of the Office Action.

Claims 6-7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Clemens in view of Dawson and further in view of U.S. Patent No. 5,866,433 to Akutsu (hereinafter “Akutsu”) for the reasons noted at pages 4-5 of the Office Action.

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Claims 8-17 and 26-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,905,446 to Benore (hereinafter "Benore") in view of Dawson for the reasons noted at page 5 of the Office Action.

These rejections are respectfully traversed for the reasons noted below. However, claims 1, 8, 18, and 26 have been amended to expedite prosecution.

First, Applicants agree that "Clemens does not . . . disclose a microprocessor" as noted at page 3 of the Office Action. (Emphasis added.) However, to expedite prosecution of claim 1, this claim has been amended to recite "a microprocessor to process the signal [i.e., the signal according to the read identification code], to receive a further signal to indicate whether the manual key is used within a set amount of time, and to operate . . ." Second, Applicants respectfully submit that Dawson does not teach or disclose a "microprocessor" to receive the "further signal to indicate whether the manual key is used within a set amount of time (e.g., predetermined amount of time after the electronic key is read or detected by the electronic key reader) as recited in the rejected claims.

Thus, even if combined with Clemens, the combination of Clemens in view of Dawson would not arrive at Applicants' claimed invention of claims 1 (and claims 2, 3, 4, 5, 6-7 depending therefrom).

Furthermore, the only motivation to combine Clemens with Dawson is that provided in Applicants' specification. To use such motivation provided solely by Applicants' specification is impermissible.

To expedite prosecution, claim 8 is amended in a fashion similar to claim 1. Claim 8 recites "a control unit to receive a signal to indicate whether the corresponding manufacturer provided key is used within a set amount of time . . ." as noted in the Listing of Claims. (Emphasis added.) By virtue of their dependency on claim 8, claims 9-17 are likewise amended.

To expedite prosecution, claim 18 is amended in a fashion similar to claim 1. Claim 18 recites "a microprocessor to process the signal, to receive a further signal to indicate whether the vehicle manual key . . . is used within a set amount of time after the electric key reader reads the identification code . . ." as noted in the Listing of Claims. (Emphasis added.) By

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virtue of their dependency on claim 18, claims 19-22, 23, 24 and 25 are likewise amended.

To expedite prosecution, claim 26 is amended in a fashion similar to claim 1. Claim 26 recites “a processor to receive a further signal to indicate whether the corresponding manufacturer key is used within a set amount of time . . .” as noted in the Listing of Claims. (Emphasis added.) By virtue of their dependency on claim 26, claims 27-32 are likewise amended. Also, as with Clemens, Applicants agree with the Examiner that “microprocessor controllers are not . . . disclosed” by Benore. See Office Action at page 5, paragraph 9, lines 13-14.

The above-noted deficiencies of Clemens in view of Dawson apply equally to the rejection of claims 8-17, 18-25, and 26-32, in part, because Clemens does not teach or disclose a microprocessor (or processor or control unit) and Dawson does not teach or disclose a microprocessor (a processor or control unit) “to receive” a signal or a further signal “to indicate whether the [relevant] key is used within a set amount of time” after the electronic key is read or detected. This is quite different from the lock-out feature noted at col. 2, lines 54-58 of Dawson – which refers to locking-out access when “attempts to operate the lock” with the appropriate “access code” are made outside the lock-out period. In particular, Dawson explains “[a]ttempts to operate the lock . . . will be met with the rejection of the access code [i.e., correct code] and inability to operate the lock successfully.”

These deficiencies of Clemens in view of Dawson are not rectified by Lee (asserted as directed to LEDs), Akutsu (asserted as directed to storage components), or Benore (asserted as directed to plural key readers and plural locks – and without a disclosure of a microprocessor controllers).

With regard to the rejection of method claims 33-38, it is noted that the only basis provided for the rejection is the sole statement:

The methods of claims 33-38 would have been obvious in view of the flow charts of Dawson showing new key detection and programming operations. [(Emphasis added.)]

Applicants respectfully submit that the foregoing statement is insufficient to determine the exact basis for the rejection (as required by MPEP § 706.02 (j) noted below) or to establish a proper *prima facie* obviousness rejection under 35 USC § 103(a). Therefore, Applicants respectfully

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request the Examiner to point to each drawing figure (and relevant portions thereof) and the corresponding description within each of the cited references – pointing to exactly where – each step of each of rejected claims 33-38 is allegedly taught, disclosed or suggested in Dawson.

To that end, Applicants direct the Examiner's attention to amended claim 33 (made to improve clarity) in which claim 33 recites "otherwise adding one to a number count for each time an incorrect [e.g., improper] electronic key is attempted to operate the at least one locking device . . ." Support for such amendment is found in the illustration of FIG. 4 operations S430 (proper key input?) and S450 (N=N+1; if "NO" proper key input), for example. This relates to an "anti-fishing" feature (e.g., in operation S420, after N = T, the locking component is disabled in operation S440 as illustrated in FIG. 4 – so that only a limited number of improper keys can be tried) which is not disclosed, taught or suggested by Dawson.

With regard to claims 34-38, Applicants respectfully reiterate their request that the Examiner specify the exact drawing figure (and relevant portion thereof), page or column, and line numbers that disclose the alleged method operations of Applicants' rejected claims. In that regard, Applicants direct the Examiner to MPEP § 706.02 (j) stating (in relevant part):

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See **MPEP § 2144 - § 2144.09** for examples of reasoning supporting obviousness rejections.
[(Emphasis added.)]

* * *

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in

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legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. [(Emphasis added.)]

In accordance with MPEP § 706.02(j), Applicants respectfully request the Examiner to communicate the basis of the rejection of claims 33-38 in such “full detail” so that the “applicant can be given a fair opportunity to reply” (and early-on during prosecution) with respect to each operation noted recited in the rejected method claims. Otherwise, Applicants respectfully request reconsideration and withdrawal of the rejection of method claims 33-38 (as amended).

For at least the foregoing reasons, Applicants respectfully submit that they have fully responded to each ground of rejection and that all the rejections of record under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

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Please charge the three-month extension of time fee of (\$510) to our credit card. If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 50-2827, as needed.

Respectfully submitted,

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